IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Jim Chu et al.   Examiner: Philip Lee

Serial No.:   09/884,674   Group Art Unit: 2448

Filed: June 19, 2001   Docket: 884.441US1

Title: SYSTEM AND METHOD FOR AUTOMATIC AND ADAPTIVE USE OF ACTIVE NETWORK PERFORMANCE MEASUREMENT TECHNIQUES TO FIND THE FASTEST SOURCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
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The Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated below:

§ 103 Rejection of the Claims

Claims 1, 3-6, 8-10, 19, and 25-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Emens et al. (U.S. Patent No. 6,606,643; hereinafter "Emens") in view of Myers et al. (U.S. Publication No. 2003/0079005; hereinafter "Myers"). The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion that a claim is obvious within § 103(a) depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). The underlying factual issues set forth in *Graham* are as follows: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ;

M.P.E.P. § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ; M.P.E.P. § 2143.03. As part of establishing a *prima facie* case of obviousness, the Examiner's analysis must show that some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id*. To facilitate review, this analysis should be made explicit. *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)). Applicant respectfully submits that the claims are not obvious because the claims recite elements not found in the combination of Emens and Myers.

For example, claim 1 recites that "the type of empirical measurement is selected according to a comparison of a size of data to be obtained from at least one of a plurality of sources with a threshold size." Claims 8, 25 and 28 as amended recite similar language. The Office Action correctly states in the rejection of claim 1 that Emens "did not teach selecting a type of empirical measurement according to a size of data to be obtained." However, the Office Action goes on to state that Myers, at paragraph [0058] teaches "selecting a type of empirical measurement (e.g., throughput) of performance from a plurality of types of empirical measurement (e.g., throughput, latency, etc.), wherein the type of empirical measurement is selected according to a size of data to be obtained from at least one of a plurality of sources ([0058]) (e.g., large files that are greater than 1MB)." Applicant respectfully disagrees with this interpretation of Myers. The cited section of Myers merely states that "many file-sharing applications deal with large files that are greater than 1 MB" and that "high-throughput paths are beneficial to file sharing applications because those files are relatively large and large amounts of data may be moved through high-throughput paths quickly." In other words, Myers is merely stating that large files benefit from high-throughput paths. However, Myers does not teach or suggest using a data size to drive the determination of a download source. Rather, Myers appears to disclose using an application or network traffic type to drive the selection of a path through a network. For example, at paragraph [0042], Myers discloses the use of "performance metrics that directly predict <u>application</u> performance." (emphasis added). Further, at paragraph [0045], Myers states that the system can use performance metrics to "choose appropriate routing

for any of a variety of applications having differing optimization needs." (emphasis added). At paragraph [0056], Myers discloses "keeping different routing metrics and a different routing table showing the most efficient routing for each type of content that passes through the system." (emphasis added). Still further, Myers discloses at paragraph [0064]that:

> The present network and method of using a network selects the most appropriate route for each application or application type by matching data to the most appropriate path to improve the routing of that data as it is sent through the network according to particular requirements of the application. (emphasis added)

Thus at various portions of Myers where a distinction is made regarding how to route network traffic, it is the type of content or the application that appears to be the distinguishing characteristic used match with low latency or high throughput characteristics to select a path through a network. Thus Myers discloses a system in which the application or content type is used to determine routing metrics. This is consistent with paragraph [0058] because certain applications may use files that tend to be large. However, it is clear that neither the cited section of Myers nor any other section of Myers teaches or suggests using a comparison of a data size with a threshold size to determine a download source. Rather, Myers uses an application or application type, not data size, to determine routing metrics.

At paragraph 55, the Final Office Action states that it is inherent that a size of the large file must be predetermined in order to be compared with [1] MB. For the inherency argument to be applicable, Myers would have to teach using a data size to determine a source for the data. As discussed above, Myers appears to use an application or content type, not a data size, in order to choose a route through a network.

In view of the above, independent claims 1, 8, 25 and 28 recite elements not found in the combination of Emens and Myers. Thus there are patentable differences between the cited art and the claims at issue. Therefore claims 1, 8, 25 and 28 are not obvious in view of the combination of Emens and Myers.

Claims 21-23 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Emens and Myers in view of Andrews et al. (U.S. Publication No. 2002/0038360; hereinafter "Andrews"). Independent claim 21, like claims 1, 8, 25 and 28, recites "selecting a type from a plurality of types of empirical measurement of performance of each of the plurality of sources,

the type of empirical measurement selected according to a comparison of a predetermined file size with a predetermined threshold file size." As discussed above, neither Emens nor Myers teach or suggest the recited language. Andrews appears to have been cited for teaching the use of socket connections and TCP/IP handshaking. However, Applicant has reviewed Andrews and can find no teaching or suggestion of selecting a type from a plurality of types of empirical measurement of performance of each of the plurality of sources, the type of empirical measurement selected according to a comparison of a predetermined file size with a predetermined threshold file size. As a result, the combination of Emens, Myers and Andrews fails to teach or suggest each and every element of Applicant's claim 21, thereby providing differences between the cited art and the claims at issue. Thus claim 21 is not obvious in view of the combination of Emens, Myers and Andrews.

Claims 7, 11, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Emens and Myers in view of Ramanathan et al. (U.S. Patent No. 5,913,041; hereinafter "Ramanathan").

Claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Emens, Myers, and Andrews in view of Ramanathan.

Claims 31-32 and 34-35 were rejected under 35 U.S.C. § 103(a) as being obvious over Emens and Myers et al. in view of Bhagwat et al. (U.S. 6,563,517).

Claim 33 was rejected under 35 U.S.C. § 103(a) as being obvious over Emens and Myers, and Andrews in view of Bhagwat.

With respect to dependent claims 3-7, 9-11, 19-20, 22-24, 26-27, and 29-35, each of these dependent claims depends from a base claim 1, 8, 21, 25 or 28 that recites selecting the type of empirical measurement according to a comparison of a size of data to be obtained from at least one of a plurality of sources with a threshold size. As discussed above, none of Emens, Myers or Andrews teaches or suggest such a selection. Further, Applicant has reviewed Ramanathan and Bhagwat and can find no teaching or suggestion that the type of empirical measurement is selected according to a comparison of a size of data to be obtained from at least one of a plurality of sources with a threshold size. Accordingly, dependent claims 3-7, 9-11, 19-20, 22-24, 26-27, and 29-35 are believed allowable over any combination of Emens, Myers,

Andrews, Ramanathan or Bhagwat for at least the reasons discussed above regarding their respective base independent claims 1, 8, 21, 25 and 28.

CONCLUSION

The Applicant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at (612) 373-6954 to discuss any questions which may remain with respect to the present application.
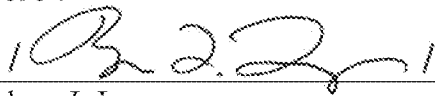
If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date ___October 1, 2009___   By _____
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 1st day of October 2009.

Rodney L. Lacy
_____   _____
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